



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,649	12/17/2001	Francis D. Palazzo	SEDN/4665/5	1815

56015	7590	01/07/2008
PATTERSON & SHERIDAN, LLP/ SEDNA PATENT SERVICES, LLC 595 SHREWSBURY AVENUE SUITE 100 SHREWSBURY, NJ 07702		

EXAMINER	
SALCE, JASON P	

ART UNIT	PAPER NUMBER
2623	

MAIL DATE	DELIVERY MODE
01/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/022,649

Applicant(s)

PALAZZO ET AL.

Examiner

Jason P. Salce

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/16/2007 have been fully considered but they are not persuasive.

Applicant traverses the examiner's 112 1st Paragraph rejection and further references portions of the specification that Applicant feels supports the claimed limitations, however, the examiner disagrees. Further, the examiner notes that another 112 1st Paragraph has risen based on Applicant's arguments (see below).

The Applicant believes that the Examiner is basing the rejection based upon confusion of terminology. Applicant states that the specification teaches that promotional metadata is broadcast in combination with programming and advertisement audio and video data (Page 9, Lines 10-11). Applicant further states that the promotional metadata comprises data items (Page 10, lines 2-3) including a promotion type, the promotion type including a purchasable event (Page 10, Lines 7-8) and an interactive advertisement (Page 10, Lines 13-15). As stated above, this creates an additional 112 1st Paragraph issue.

Note that the claims specifically state that the broadcast audio and video content is further received along with a promotional metadata file associated with the broadcast audio and video content, the promotional metadata including a plurality of data items, the data items including a promotion type, the promotion type including a purchasable event **AND** an interactive advertisement. The examiner notes that the specification clearly teaches that only one promotion

type is included in a single promotional metadata file. For example, Figure 2 represents a purchasable event promotion type in a single promotional metadata file, while Figure 3 teaches an interactive advertisement promotion type in a single promotional metadata file. Further support that these are two separate files is clearly taught on Page 10 and Page 12, Lines 18-20 of Applicant's specification. Therefore, it is impossible for a single promotional metadata file, taught by Applicant's specification, to include both a purchasable event and an interactive advertisement, as claimed. Each promotion type is included in a separate promotional metadata file and should be claimed as such.

In regards to the previous 112 1st Paragraph rejection, Applicant further notes that Pages 10 and 11 support the claimed limitations. Applicant states, "One of the EPG actions available from within the advertisement may be storing the advertisement (i.e. the advertisement being presented). The examiner notes that the example given by the Applicant is stated nowhere in these portions of the specification. The specification does not clearly distinguish between an advertisement currently being displayed or displayed at a future time. Applicant further notes that Figure 6 further provides support for Pages 10 and 11 of the specification, however Figure 6 is explained in detail on Pages 17 and 18 of Applicant's specification. As stated on Pages 17-18, the advertisement that is to be recorded is clearly distinguished from the "promotional" being displayed. This is further supported by Figure 5 of the specification. Therefore, Applicant's own specification actually supports that the advertisement being recorded is separate

from the "promotional" advertisement being displayed. Therefore, Applicant's specification does not clearly disclose recording an advertisement during presentation of the advertisement.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to independent claims 16-32, the claims recite the limitations, "presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing, **during presentation of the interactive advertisement**". The examiner notes that this is in direct contradiction with what is taught by the specification.

Note Figure 6, Page 3, Lines 9-15 and Pages 17-18 where the interactive advertisement is only recorded if the interactive advertisement is not presently playing. For example, if the interactive advertisement is currently playing, the

channel will be force tuned to the channel playing the interactive advertisement (not recorded), therefore the claim could never be supported by the specification where an interactive advertisement is recorded while it is currently playing.

Specifically note Page 3, Lines 9-15, where the specification specifically states,

"The video window contains promotional programming such as an advertisement for a sports event or movie, whether presently playing or scheduled to be broadcast at a future time/or date. By selecting the video window, the viewer may view expanded information about the event and, if desired, be AUTOMATICALLY OR FORCE TUNED TO THE PROGRAM

BEING PROMOTED". The specification separately teaches, ***"If the event being promoted is to be aired IN THE FUTURE, THE VIEWER IS DIRECTED TO DIALOGS FOR SETTING A PROGRAM REMINDER OR TO PROGRAM A VIDEO RECORDING DEVICE"***. Therefore, the specification teaches away from

what is claimed. The only time a program is reserved for a recording is when it is to be broadcast in the future, therefore an actual recording cannot be performed during presentation of the interactive advertisement. Also note Figure 6 and Pages 17-18 where the viewer is viewing a "promotional" and further access the "promotional" to record an "advertisement", clearly the specification distinguishes between what is viewed and what is being recorded in addition to the specification to specifically teaching recording while the advertisement is currently being presented.

In regards to the previous 112 1st Paragraph rejection, Applicant further notes that Pages 10 and 11 support the claimed limitations. Applicant states,

"One of the EPG actions available from within the advertisement may be storing the advertisement (i.e. the advertisement being presented). The examiner notes that the example given by the Applicant is stated nowhere in these portions of the specification. The specification does not clearly distinguish between an advertisement currently being displayed or displayed at a future time. Applicant further notes that Figure 6 further provides support for Pages 10 and 11 of the specification, however Figure 6 is explained in detail on Pages 17 and 18 of Applicant's specification. As stated on Pages 17-18, the advertisement that is to be recorded is clearly distinguished from the "promotional" being displayed. This is further supported by Figure 5 of the specification. Therefore, Applicant's own specification actually supports that the advertisement being recorded is separate from the "promotional" advertisement being displayed. Therefore, Applicant's specification does not clearly disclose recording an advertisement during presentation of the advertisement.

Further note that the claims specifically state that the broadcast audio and video content is further received along with a promotional metadata file associated with the broadcast audio and video content, the promotional metadata including a plurality of data items, the data items including a promotion type, the promotion type including a purchasable event **AND** an interactive advertisement. The examiner notes that the specification clearly teaches that only one promotion type is included in a single promotional metadata file. For example, Figure 2 represents a purchasable event promotion type in a single promotional metadata file, while Figure 3 teaches an interactive advertisement promotion type in a

single promotional metadata file. Further support that these are two separate files is clearly taught on Page 10 and Page 12, Lines 18-20 of Applicant's specification. Therefore, it is impossible for a single promotional metadata file, taught by Applicant's specification, to include both a purchasable event and an interactive advertisement, as claimed. Each promotion type is included in a separate promotional metadata file and should be claimed as such.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason P Salce
Primary Examiner
Art Unit 2623

January 2, 2008

JASON SALCE
PRIMARY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Jason Salce', written in a cursive style.